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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,272	10/31/2003	Stefek Malkowski Zaba	200308879-2	7911

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H/A

Office Action Summary	Application No. 10/697,272	Applicant(s) ZABA ET AL.	
	Examiner Daniel I. Walsh	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 17 February 2006.

2. Claim 21 is objected to because of the following informalities:

Replace "detection" with -- detecting --.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 5, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arrieta, as cited in the previous Office Action, in view of Azuma (US 6,704,608).

The teachings of Arrieta have been discussed in the previous Office Action. Namely, Arrieta teaches security document comprising a printed document and one or more circuits to be read wirelessly that are incorporated into the document and that the memory circuit is physically isolated so as to inhibit tampering or configured to indicate when tampering has occurred (abstract). Arrieta teaches that the emitter (radio frequency, as per claim 3) is integrated into the hologram. The Examiner interprets the hologram to broadly be interpreted as a tamper evident strip. The Examiner notes that the teachings of Arrieta are interpreted to extend to include those of an identification card, which is listed as a security document (paragraph [0002]). Re claim 5, as the antenna is connected to the IC which is integrated into the substrate, the antenna is therefore interpreted to be configured for detection or resistance of physical tampering.

Arrieta is silent to protecting the memory circuit from access by an unauthorized reader.

Azuma teaches mutual authentication for increased security (abstract). This is interpreted to include protecting access from an unauthorized reader. Re claim 2, Azuma teaches the power is provided from the reader (abstract), or that the card is passive. It would have been obvious to use inductive power means, in order to reduce document cost/size/complexity as is known in the art.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Arrieta with those of Azuma.

One would have been motivated to do this for increased security.

Re claim 18, FIG. 2 of Arrieta shows the circuit on an external surface of the document exposed to the environment.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arrieta/Azuma, as discussed above, in view of Habara et al. (US 2003/0136851).

The teachings of Arrieta/Azuma have been discussed above.

Arrieta/Azuma is silent to identifying an authorized bearer of the security document and that the document allows access to asset(s) of the bearer.

Habara et al. teaches the document is used to identify/authenticate an authorized bearer of the document (abstract). The Examiner has interpreted permitting entrance to authorized users to certain areas, as means to access assets, as the identification provided by the card permits entrance into areas where assets could be located. Additionally, the Examiner notes that it is well known and conventional in the art for security documents/cards to be presented by a user to verify themselves for access to an area, services, safe deposit boxes, restricted areas, etc. (by presentation of id cards, passports, bank cards, drivers license, etc.), where assets can be located.

5. Claims 8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Azuma (US 6,704,608).

Re claim 8, Azuma teaches a printed document (FIG. 1A). The printed document includes printed information and second information for writing to a memory circuit (13) of the printed document. The second information is protected from unauthorized reading as mutual authentication with a reader/terminal (abstract) is required. Mutual authentication is understood to include verifying the document/card and reader, for security purposes. The Examiner notes that though the teachings of Azuma are silent to the creation of the document (printing on the document and writing to the memory circuits), the Examiner notes that it would have been obvious to one of ordinary skill in the art to print first information on the document and write

second information into the memory (read wirelessly as shown in FIG. 1A), as such means are well known and conventional in the art to produce a card/document and provide for readable (man) and machine readable information (stored), to provide conventional card/document functionality. The Examiner notes that the circuit/memory is understood to be isolated to inhibit physical tampering/physically located, as it is disposed in one of the layers of the document. Tampering with the memory would also be visibly discernable.

Re claims 11-12, the teachings have been discussed above. The Examiner notes that it would have been obvious to one of ordinary skill in the art to determine information before its printed/written in order to create the card/document, and that circuits are attached in/on the card/document as is conventional in the art to store information. Indicia/information printing on a card/document is well known in order to provide information about the user, manufacturer of the card/document, etc.

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Habara et al. (US 2003/0136851) in view of Azuma, as discussed above.

Habara et al. teaches reading first information printed in the printed document and wirelessly reading second information in a memory circuit and using the second information with the first information to assess the document/compare characteristics of the bearer of the document (abstract and paragraph [0052] which teach comparing the printed identification data to the stored data read out to verify a user).

Habara et al. is silent to obtaining authorization information to read the document, wirelessly powering the document, and reading the second information in the memory circuit using authorization information.

The teachings of Azuma have been discussed above. Azuma teaches powering the document (abstract) and mutual authentication as is understood with mutual authentication; authorization information is obtained, by verifying the reader/(card/document), in order to read the stored information of the security document.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Azuma with those of Habara et al.

One would have been motivated to do this to increase the security associated with card/document information.

7. Claim 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldi (US 56,547,151) in view of Conwell (US 2002/0135481).

Baldi teaches a printed document (paper), one or more memory circuits to be read wirelessly attached to or incorporated into the printed document, that the memory circuit is protected from access by an unauthorized reader and that the memory circuit is isolated so as to inhibit or indicate when physical tampering has occurred (FIG. 3, as Baldi). As the stored data is encrypted, it is interpreted as protected from access by unauthorized readers (will not be able to decrypt the data). As the memory circuit is disposed, physical tampering/removal/damage or the circuit would be visible and could prohibit those from damaging it because it could be visually detected.

Baldi is silent to tamper evident strips providing a visual indication as to whether the circuit has been tampered with, that the strips correspond to at least one cut on the printed document adjacent the circuit.

Conwell teaches such limitations (FIG. 5).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Baldi with those of Conwell.

One would have done this for additional security.

Re claims 15, Baldi teaches paper, as discussed above.

8. Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (US 2004/0060978).

Okamoto et al. teaches a printed document with one or more memory circuits to be read wirelessly that are attached to or incorporated into the document, protecting data from unauthorized readers, that the memory circuit is physically isolated to inhibit physical tampering or indicate when tampering has occurred, and that the printed and memory data identifies a bearer of the document (abstract and FIG. 1). The Examiner notes that as the data is encrypted, it is interpreted as being protected from access by unauthorized readers. Fig. 6 teaches that the chip and scanned information are matched for authenticity. Accordingly, as Okamoto et al. teaches that the document can be mail, paper currency, certificate of share/stock, gift certificate, etc. (paragraph [0118]+), the Examiner notes it would have been obvious that for at least mail or a gift certificate, that printed information would include a name. As such, it has been discussed that the printed information is also stored on the chip. Therefore, the Examiner notes it would have been obvious to one of ordinary skill in the art for the data to identify a bearer, in such instances, as such printed data is conventional in the art for identification purposes on such paper documents

Re claim 17, the limitations have been discussed above (see FIG. 3).

Re claims 19 and 20, Okamoto et al., as discussed above, teaches the circuits on the outside (FIG. 3 and mounting unit 23).

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are not persuasive.

In response to the Applicants argument that a hologram cannot correspond to a tamper evident strip, the Examiner disagrees. Broadly interpreted, a hologram can be interpreted as a tamper evident strip, because removal or destruction/damage of the hologram, interpreted as a strip, provides evidence of tampering.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the hologram provides tamper resistance) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims recite a tamper evident strip, and do not require that the hologram of Arrieta provide tamper resistance, just that tamper evidence is provided. Additionally, the Examiner notes that "tamper evident" is sufficiently broad, and that depending on the degree of tampering, almost any component/sticker/hologram/etc. can be seen as tamper evident or even tamper resistance, since certain tampering would be evident.

Re the Applicants argument that mutual authentication does not stop physical tampering, the Examiner notes that such features are not recited in the claims. The Examiner notes that mutual authentication is indeed a security measure that protects from access by an unauthorized reader.

Re the Applicants argument that Arrieta and Azuma are directed to much different purposes, the Examiner disagrees, noting that Arrieta, as discussed above, can be applied to cards as well. Arrieta is drawn to the circuitry/memory and is not precluded from being used in other applications, such as cards taught by Azuma, for example.

Re the Applicants argument that support for a security document including means to allow access to a specific asset(s) by the authorized bearer requires support, the Examiner notes Habara et al. as discussed above, teaches identification means to allow entry into a restricted area, for example. This is broadly interpreted to include access to assets.

Re the Applicants argument (re claims 8, 11 and 12) that Azuma does not teach printed document, the Examiner disagrees. It is well known and conventional in the art for cards to have indicia/print on them for identification purposes, for example, thus being interpreted as a printed document.

Re the Applicants argument (re claims 9-10) that the guard checks the card ant that wireless reading and powering does not occur, the Examiner disagrees. Paragraph [0051-0052] teaches the card is read by a chip reader via radio waves. The teachings of wirelessly powering the card has been discussed above and is well known and conventional in the art.

Allowable Subject Matter

10. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach, re claim 21, that the memory circuit includes means for detecting a change in a physical property of the antenna, the change in the physical property being indicative of physical tampering of the antenna, wherein the memory circuit includes means for disabling the reading of the memory circuit when the physical tampering of the antenna is detected.

The Examiner notes that it is well known and conventional that when antennas are broken, or disrupted in cards/documents that they cannot function. Additionally, Walker et al. (US 2005/0085951) teaches that an antenna in a car is detected when damage or it is removed, but this is not seen as applicable to the current Application, and doesn't teach deactivating memory access of a security document.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Schneider (US 2005/0181160), Schneider et al. (US 2003/0164611), Lane et al. (US 2004/0233040), Ladyansky (US 2003/0024994), Bason et al. (US 2005/0274794), Krul et al. (US 2005/0109851), Yamazaki et al. (US 2004/0189672), Nicolas 9US 2006/0055506), Lindsay et al. (US 2005/0242957), and Walker et al. (US 2005/0085951).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

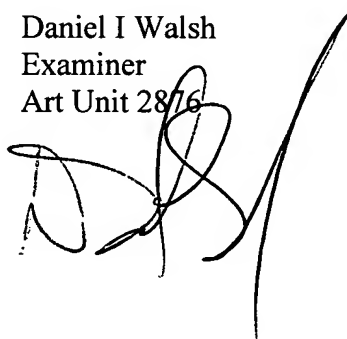
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876

A handwritten signature in black ink, appearing to be 'D. Walsh', written over the printed name and title.